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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,743	03/15/2004	Kazuhiro Masuda	119096	9229

25944 7590 06/23/2006

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EXAMINER

DICKEY, THOMAS L

ART UNIT	PAPER NUMBER
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2826

DATE MAILED: 06/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/799,743

Applicant(s)

MASUDA, KAZUHIRO

Examiner

Thomas L. Dickey

Art Unit

2826

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 June 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

TECHNOLOGY CENTER 2800

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

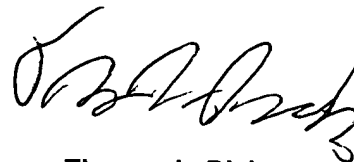
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1, 2 and 5-9.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.



Thomas L. Dickey

Patent Examiner

Art Unit 2826

Continuation of 3. NOTE: It is argued, at page 5 of the remarks, that "Specifically, Applicant submits that the Hanaoka '011 publication fails to disclose or suggest at least the combination of features including a through-hole through the substrate and the electrode having a first diameter in the substrate that is smaller than a second diameter in the electrode, as disclosed in the present application and recited in [the proposed amendment to] claim 1. Rather, in the Hanaoka '011 publication structure, the through-hole has a first diameter in the substrate that is greater than a second diameter in the electrode (see Figs. 5-9 and 11)." The novelty of the present claims compared to Hanaoka '011 (the art used to successfully reject the previously claimed version and, as likely as not, the closest art to the version of the claims Applicant now proposes) is the substitution of a through-hole that is narrow, and then broad, for Hanaoka '011's through-hole that broad, and then narrow.

The claimed difference, clearly, is novel against Hanaoka '011. But is it non-obvious? One having skill in the art would already possess the ability to make a through-hole that is narrow and broad at different locations. If he were so minded he could easily use this skill to substitute a through-hole that goes from narrow to broad for a through-hole that goes from broad to narrow. But would one skilled in the art be so minded, in other words, is there some "motivation, suggestion, or teaching that would have led the skilled artisan at the time of the invention to the claimed combination as a whole?" *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998).

The question of motivation is part of the *Graham v. John Deere* factual inquiry into "the scope and content of the prior art," "the differences between the prior art and the claims at issue," and "the level of ordinary skill in the pertinent art." *In re Kahn*, 78 USPQ2d 1329, 1335 (Fed.Cir. 2006). Resolving this factual question requires evidence. *Id.* Failure to find and examine such evidence is a legal error leading to the inference that hindsight has been used to conclude that the invention was obvious. *Id.*, citing *In re Dembiczak*, 175 F.3d 994, 998 (Fed. Cir. 1999) and *Giles S. Rich, Laying the Ghost of the Invention Requirement*, 1 APLA Q.J. 26-45 (1972), reprinted in 14 Fed. Cir. B.J. 163, 170 (2004).

Applicant proposes a simple change in the claims, a change well within the skill of one skilled in this art. Finding the best available evidence that might motivate one of skill in the art to modify (or not modify) the Hanaoka '011 device to reach the claimed combination and determining that it meets (or fails to meet) the requirements of § 103 is thus crucial to the question of patentability. However, the search for such evidence is a new search. The question of the obviousness of the newly claimed combination, based on the evidence so found, is a new question not previously considered..